

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

Docket No: Q62357

RECEIVED

Yves LE GENDRE, et al.

JUL 19 2004

Appln. No.: 09/739,305

Group Art Unit: 2681

Technology Center 2600

Confirmation No.: 3328

Examiner: Erika A. GARY

Filed: December 19, 2000

For: A METHOD OF OBTAINING INFORMATION ON THE IDENTITY OF A CALLER IN
A TERMINAL OF A TELEPHONE COMMUNICATIONS NETWORK

SUBMISSION OF APPELLANT'S BRIEF ON APPEAL

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith please find an original and two copies of Appellant's Brief on Appeal. A check for the statutory fee of \$330.00 is attached. The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account. A duplicate copy of this paper is attached.

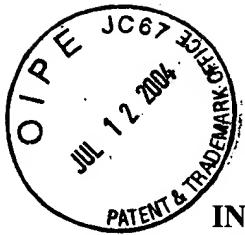
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Date: July 12, 2004



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APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. § 1.192

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is an Appeal from the final rejection of January 8, 2004 in Application No. 09/739,305. In accordance with the provisions of 37 C.F.R. § 1.192, Appellants submit the following:

I. REAL PARTY IN INTEREST

The real party in interest in this appeal is Alcatel. Assignment of the application was submitted to the U.S. Patent and Trademark Office on December 19, 2000, and recorded on the same date at Reel 011384, Frame 0848.

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II. RELATED APPEALS AND INTERFERENCES

There are no known appeals or interferences that will affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-14 are pending in the application. Claims 1-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over DeFazio et al. (U.S. Patent No. 5,940,484; hereafter "DeFazio") in view of Grube et al. (U.S. Patent No. 5,557,605; hereafter "Grube"). All of the claims are set forth in the attached Appendix.

IV. STATUS OF AMENDMENTS

No claim amendments were requested subsequent to the Final Office Action of January 8, 2004. The Request for Reconsideration filed April 8, 2004 is believed to be of record.

V. SUMMARY OF THE INVENTION

The present invention is directed to a method and terminal for obtaining information regarding the identity of a caller for incoming calls. (page 1, lines 4-6). As shown in the Figure, a public switched telephone network (PSTN) 1 is connected to a private automatic branch exchange (PABX) 2 of a private network and a radio interface 4 (typically a base transceiver station) for transmission via a public mobile network. A terminal 10 (e.g., a mobile station of a

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mobile public network) communicably linked to the radio interface 4. A wireless application protocol (WAP) server 6 enables data services, and in particular Internet services, to be offered on terminals of public mobile networks. The WAP server is connected to the radio interface 4, to the PSTN 1 and to the Internet and/or an intranet 8. (page 5, lines 21-34).

When the terminal 10 receives an incoming call, the terminal 10 also receives the caller's number from the mobile network. The terminal 10 includes a directory 12 which can be used to search for a directory entry in which the telephone number is identical to the caller's number. The terminal also includes an agent 14 (i.e., a program or an application) which prepares one or more requests indicating the caller's number and whose objective is to identify the caller on the basis of the caller's number. The agent can be activated on receiving the caller's number, or if checking the directory shows that there is no directory entry with the same telephone number, or after the end of the incoming call for which the caller's number was transmitted. The agent can also be activated each time that a caller's number is shown on the user's terminal. (page 5, line 35 - page 6, line 18).

The request can be addressed to any source of identification information including a data server, a search engine or a WAP portal. The request prepared by the agent can be sent on any channel available to the terminal such as a data channel in connectionless or connected packet mode or a voice channel with dual tone multi-frequency (DTMF) coding or a low-speed modem. The response to the requests can be returned to the terminal via the same channel or different

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channels. The requests can be prepared by the agent on the basis of a request file 18 which can contain all possible requests. (page 6, line 30 - page 7, line 20).

If the result of the request corresponds to the required identification (i.e., a user name), the agent can display the information obtained or store it in the directory, with or without validation by the terminal user. If the result does not correspond to the required identification information, the agent can ignore the result and trigger a next request. (page 7, line 30 - page 8, line 2).

VI. ISSUES

Whether claims 1-14 are erroneously rejected 35 U.S.C. § 103(a) as being unpatentable over DeFazio in view of Grube?

VII. GROUPING OF CLAIMS

Appellant submits that claims 1-14 stand and fall together. Reasons for patentability are set forth below.

VIII. ARGUMENTS

Appellant respectfully submits that claims 1-14 would not have been rendered obvious in view of DeFazio and Grube because (1) the cited references do not teach or suggest all of the

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features of the claims and (2) one of ordinary skill in the art would not have been motivated to combine and modify the cited references to produce the claimed invention.

Independent claim 1 is directed to “[a] method of obtaining information regarding an identity of a caller in a terminal of a telephone communications network, wherein the terminal comprises an agent including a program or an application which is stored and activated on the terminal.” Claim 1 recites:

receiving at the terminal an incoming call from a caller and a telephone number of the caller;

selecting at the agent of the terminal at least one external server likely to be able to provide the information regarding the identity of the caller;

preparing at the agent of the terminal a request indicating the telephone number of the caller and requesting the information regarding the identity of the caller; and

sending from the agent of the terminal the request to the server.

Claim 7 is directed to a terminal of a telephone communications network and recites limitations similar to those in claim 1 except in apparatus format.¹

With regard to independent claims 1 and 7, the Examiner alleges that DeFazio discloses all of the features of the claimed invention except for “the agent resides in the terminal and includes a

¹ Claim 7 recites that “the terminal compris[es] an agent for configured to select at least one external server likely to be able to provide information regarding an identity of a caller, prepare a request indicating the telephone number of the caller and requesting the information regarding the identity of the caller, and send the request from the terminal to the server, wherein the agent comprises a program or an application which is stored and activated on the terminal.”

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program or an application that is stored and activated on the terminal", which the Examiner contends is disclosed by Grube. Further, the Examiner asserts that "it would have been obvious to one of ordinary skill in the art to modify DeFazio to include Grube ... to allow the terminal to request the caller data as it is not always needed or desired ... [and because] it is known in the art to relocate one component's functionality to another component."

DeFazio discloses a self-provisioning names database which adds new names to a database for associating names to calling address data in a caller identification with name delivery service each time a new caller places a call to a service subscriber. (Abstract). As shown in Figure 1, a calling party 1 places a call through the public switched telephone network 2 and is ultimately connected to a local switch 3 serving a called subscriber 4 having a telephone and an associated caller identification display unit 4a. A names database 5 is communicably linked to the local switch 3. A national or other names database 6 is communicably linked to the names database 5. When the calling party 1 initiates a call to the called subscriber 4, the local switch (or private branch exchange switch) requests the names database to provide a name associated with the telephone number of the calling party 1. The database 5 queries itself, and if no name is found, initiates a further query to national database 6. If a name is found in the database 5 or the national database 6, the name is provided to the called subscriber 4 when the call is connected to the called subscriber 4. (col. 3, line 27 - col. 4, line 4).

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Grube discloses a method for providing caller data in a time division multiplexed (TDM) radio communication system. With reference to Figure 1, a source communication unit (mobile radio) 101 transmits a voice message to a target communication unit (mobile radio) 103 via over a RF carriers 107, 108. The target mobile radio 103 transmits a caller data request regarding the geographic location, heading, speed, and/or radio status (i.e., remaining battery life, service capabilities or warranty information) of the source mobile radio 101. The caller data request can be sent directly to the source mobile radio 101 or to a central controller 106 which can store and gather data relating the geographic location, heading, speed, and/or radio status of the source mobile radio 101. The requested caller data is then included with a subsequent voice message transmission to the target mobile radio 103. (Figs. 1 and 2; and columns 2-3).

Appellant respectfully submits that the cited references do not teach or suggest a terminal comprising the claimed agent which select at least one external server likely to be able to provide information regarding the identity of the caller and transmit to the server a request a request indicating the telephone number of the caller and requesting the information regarding the identity of the caller. As the Examiner correctly concedes, DeFazio does not disclose "the agent resides in the terminal and includes a program or an application that is stored and activated on the terminal."² Rather, DeFazio simply discloses that when the local switch of the telephone network

² January 8, 2004 Office Action at page 2, last paragraph.

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receives a call to the called subscriber, the local switch requests a names database to provide a name of the calling party.

In view of the deficiencies of DeFazio, the Examiner cites Grube for allegedly “disclos[ing] providing caller data wherein the terminal comprises an agent to request data from an external server.”³ In support of rejection, the Examiner cites column 2, lines 5-15 of which states that “the target communication unit transmits, during transmission of the voice message, a caller data request regarding the source communication unit”. However, as explained in detail in Grube, this caller data request is not directed to or concerned with the identity of the source communication unit. Rather, Grube teaches sending from the target mobile radio a caller data request for information regarding the geographic location, heading, speed, and/or radio status of the source mobile radio. As discussed in the “Background of the Invention” section of Grube, it is known in the art to add source identity information (push-to-talk identification and/or alias name) to the beginning of a message from the source mobile radio to the target mobile radio. Thus, Grube is concerned with obtaining additional information (i.e., information other than the identity of the caller) from the source mobile radio such as the geographic location, heading, speed, and/or radio status of the source mobile radio. Thus, nowhere does Grube teach or suggest sending from the

³ January 8, 2004 Office Action at page 3, first paragraph.

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target mobile radio a request for information regarding the identity of the source mobile radio, as required by the claims.

The Examiner contends that "DeFazio and Grube are combinable because they are from the same field of endeavor, that is, providing caller data to a called party."⁴ In addition, the Examiner further asserts that the references are properly combinable because "it is well known in the art to implement features of a wireless network into a telephone network and vice versa."⁵ However, Appellant respectfully submits that one of ordinary skill in the art would not have been motivated to modify the teachings of DeFazio based on Grube to produce the claimed invention.

Grube is directed to a mobile radio system rather than a telephone network. In a mobile radio system such as Grube, communications between mobile two-way radios which alternately transmit and receive data with each other through discrete operations rather than via an established/continuous call between telephone terminals. Thus, the mobile radio system of Grube and the telephone network of DeFazio utilize different network architectures and communication protocols. As a result, the Examiner's assertion that "motivation for this combination, as suggested by Grube", would have been to allow the terminal to request the caller data as it is not always needed or desired", is related to a facet of mobile radio system which is not a concern in telephone

⁴ January 8, 2004 Office Action at page 3, second paragraph.

⁵ April 28, 2004 Advisory Action at page 2.

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networks such as DeFazio. As discussed above, the teachings of Grube are directed obtaining information from the source mobile radio other than the identity of the source mobile (i.e., the geographic location, heading, speed, and/or radio status of the source mobile radio) since source identity information (push-to-talk identification and/or alias name) is typically added to the beginning of messages from the source mobile in conventional mobile radio communication systems. However, such additional information is not a concern or applicable to a standard telephone network such as DeFazio.

In mobile radio systems, each transmitted message is treated as a distinct communication which is allocated a communication resource (channel) for a one time use (i.e., a single continuous communication channel is not established between the mobile radios). On the other hand, in telephone communications, once a call is established, bi-directional communications are continuous until the call is terminated by either party. Thus, Grube's statement regarding the "ability to indicate if the caller data is even desired" (at column 1, lines 31-39) is related to the case where two mobile radio are repeatedly transmitting and receiving with each other such that there is no need to identify the transmitting mobile radio with each transmission. However, this situation would not occur in a telephone network due to the nature of the communications (i.e., no series of discrete calls/messages back and forth between the parties). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious

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unless the prior art suggests the desirability of the modification. See *In re Fritch*, 23 U.S.P.Q.2d 780 (Fed. Cir. 1992).

Lastly, Appellant respectfully submits there is no basis for the Examiner's conclusion that "it would have been obvious to one of ordinary skill in the art to modify DeFazio to include Grube ... [because] it is known in the art to relocate one component's functionality to another component." In particular, the characterization of certain limitations or parameters as obvious does not make the claimed invention, considered as a whole, obvious. It is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Appellant respectfully submits that the present invention is not a rearrangement of parts and does not simply move the functionality of one component to another. Nowhere do the cited references teach or suggest selecting at an agent of the terminal at least one external server likely to be able to provide information regarding the identity of the caller and transmitting from the agent of the terminal to the server a request indicating the telephone number of the caller and requesting the information regarding the identity of the caller, as required by the claims. Although various methods of providing information regarding the identity of the caller to a called party are known in the art, as discussed in the "Background of the Invention" section of the present application, the present invention provides a solution which identifies a caller independently of any given server thereby providing the advantage over the prior art by enabling

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a more comprehensive search and a greater probability of a successful response. (page 2, line 36 - page 3, line 3; and page 8, lines 3-7).

In view of the above, Appellant respectfully submits that even when the claims are given their broadest possible interpretation, the applied references, alone or in combination, do not teach or suggest the unobvious features recited in claims 1-14. Therefore, Appellant respectfully submits that the rejection of the claims should be reversed and the claims passed to issue.

The present Brief on Appeal is being filed in triplicate. Unless a check is submitted herewith for the fee required under 37 C.F.R. §1.192(a) and 1.17(c), please charge said fee to Deposit Account No. 19-4880.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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Date: July 12, 2004

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APPENDIX

CLAIMS 1-14 ON APPEAL:

1. (Previously Presented) A method of obtaining information regarding an identity of a caller in a terminal of a telephone communications network, wherein the terminal comprises an agent including a program or an application which is stored and activated on the terminal, the method comprising:

receiving at the terminal an incoming call from a caller and a telephone number of the caller;

selecting at the agent of the terminal at least one external server likely to be able to provide the information regarding the identity of the caller;

preparing at the agent of the terminal a request indicating the telephone number of the caller and requesting the information regarding the identity of the caller; and

sending from the agent of the terminal the request to the server.

2. (Previously Presented) The method of claim 1, further comprising:

receiving at the agent of the terminal a response to the request from the server; or

if a response to the request is not received at the agent, or if the response is not satisfactory, selecting at the agent another server likely to be able to provide said information on the identity of the caller, preparing at the agent another request indicating the telephone number

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of the caller and requesting the information regarding the identity of the caller, and sending from the agent the other request to the other server.

3. (Previously Presented) The method of claim 2, wherein the steps of receiving the response or selecting another server, preparing another request, and sending the other request to the other server are repeated if the response to the other request is not received at the agent or if the response to the other request is not satisfactory.

4. (Previously Presented) The method of claim 1, wherein the step of selecting at the agent at least one external server likely to be able to provide said information on the identity of the caller is performed by searching a request file.

5. (Previously Presented) The method of claim 1, wherein the terminal has a data channel and wherein the request is sent on the data channel.

6. (Original) The method of claim 1, wherein the terminal is a mobile terminal.

7. (Previously Presented) A terminal of a telephone communications network in which a telephone number of a caller is transmitted to the terminal at the time of an incoming call to the terminal, the terminal comprising an agent for configured to select at least one external server

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likely to be able to provide information regarding an identity of a caller, prepare a request indicating the telephone number of the caller and requesting the information regarding the identity of the caller, and send the request from the terminal to the server, wherein the agent comprises a program or an application which is stored and activated on the terminal.

8. (Previously Presented) The terminal of claim 7, wherein the agent is configured to receive a response to the request from the server, and if there is the response is not received, or if the response is not satisfactory, select another server likely to be able to provide said information on the identity of the caller, prepare another request indicating the telephone number of the caller and requesting the information regarding the identity of the caller, and send the other request to the other server.

9. (Previously Presented) The terminal of claim 8, wherein the agent is configured to select another server, prepare an additional request, and sending the additional request to the other server if there is no response to the other request or if the response to the other request is not satisfactory.

10. (Previously Presented) The terminal of claim 7, wherein the agent is configured to access a request file to select the server and prepare the request.

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11. (Previously Presented) The terminal according to claim 7, wherein the terminal has a data channel and wherein the request is sent on the data channel.

12. (Original) The terminal according to claim 7, wherein the terminal is a mobile terminal.

13. (Original) The terminal of claim 7, wherein the terminal is a fixed terminal connected to the telephone network.

14. (Original) The terminal of claim 7, wherein the terminal is a fixed terminal having access to the Internet.